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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,102	12/10/2003	Osama Elkady	50277-2319	9183
43425 7590 05/11/2010 HICKMAN PALERMO TRUONG & BECKER/ORACLE 2055 GATEWAY PLACE SUITE 550 SAN JOSE, CA 95110-1083				
EXAMINER MCLEAN, NEIL R				
ART UNIT 2625		PAPER NUMBER		
MAIL DATE 05/11/2010		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/733,102

Applicant(s)

ELKADY ET AL.

Examiner

Neil R. McLean

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1-29 and 31 are now pending in this application.
Claims 1, 8-10, 13-15, 22-24, and 27-28 are amended.
Claims 30 and 32 are canceled.

Response to Arguments

2. Regarding Applicant's Argument (page 12; lines 7-24):

“The cited references fail to teach or suggest such a method for at least the following reasons:

(1) Neither reference teaches that a merge utility responds to a request to merge a document in an original format with a document in a merge format.

(2) Neither reference features a merge utility that causes a document to be converted from an original format to a merge format.

Examiner's Response:

Barry does not disclose expressly a document in an original format;
wherein the second document was created in said original format by a first document authoring application;

in response to the request, causing the second document to be converted from the original format to the merge format to create a second merge document;

wherein the original format is a format that is not supported by the output device and therefore needs to be converted to another format that is supported by the output device in order to be properly interpreted by the output device.

Schwier discloses a document in an original format (Figure 6; Winword document 35); wherein the second document was created in said original format by a first document authoring application (Winword); in response to the request (In order to merge the system must receive a merge command/request from the browser or program code), causing the second document to be converted from the original format to the merge format to create a second merge document (Document converted to PCL format; Column 8, lines 13-14); wherein the original format is a format that is not supported by the output device and therefore needs to be converted to another format that is supported by the output device in order to be properly interpreted by the output device (Figure 8 shows an Application 45 created in Microsoft Word which is converted by Printer Processor 49 to PCL which is a printer language that the printer understands).

Schwier & Barry are combinable because they are from the same field of endeavor of image processing; e.g. both references discloses methods of merging print jobs and converting them into a format that can be understood by printers. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to convert a document from e.g. Word for Windows format to PCL or Postscript prior to merging that document with another PCL or Postscript formatted document. The suggestion/motivation for doing so is to avoid substantial time delays because the static

data must be continuously transmitted from the generating computer system to the printer device, i.e. with every individual document as disclosed by Schwier in the Background of Invention. Schwier further discloses that when two documents are merged and when the data from one document contains the same information, that RAM memory, disk storage, transmission capacity etc. are adversely affected and result in reduced printing performance. As a result, data to be displayed or printed must be first rasterized by a raster image processor (RIP), which utilizes complex and time-consuming computational routines which further increase production time to an economically impractical level. Therefore, it would have been obvious to combine Schwier's conversion of a Windows based document into a print language such as PCL or postscript with Barry's Distributed Print Job Method to obtain the invention as specified to quickly produce customized and/or personalized information within a single production run.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barry et al. (US 7,099,027) hereinafter 'Barry' in view of Schwier et al. (US 7,202,972) hereinafter 'Schwier'.

Regarding Claim 1: (Currently Amended)

Barry discloses a method comprising:

receiving, at a merge utility (Figure 8: Summing Junction 804) executing on a computer system (e.g., Workstation), a request to merge (In order to merge the system must receive a merge command/request from the browser or program code) a first merge document (802 PDL in) with a second document (New PDL Info 806)

wherein the second merge document is in the merge format (PDL);

wherein the step of converting is performed by either the merge utility or the first document authoring application (The Summing Junction 804 merges new PDL information from Block 806 with the original PDL input job; Column 13, lines 15-18);

the merge utility merging the first merge document and the second merge document to generate a composite merge document (The output of the summing clock 804 which is in PDL format; Column 13, lines 18-19); and

after generating the composite merge document delivering said composite merge document to an output device (e.g., PDL document is sent to printer);

wherein the output device is a device that is different from the computer system (e.g., Figure 18; Output Device is Printer 1810, and Computer System is Workstation 1802);

wherein the merge format is a format that is supported by the output device (e.g., PDL); and

therefore does not need to be converted to another format that is supported by the output device in order to be properly interpreted by the output device (The Printer inherently understands PDL).

wherein the method is performed by one or more computing devices (e.g., the plurality of workstations 1802 in the job distribution printing system of Figure 18; Column 21, lines 21-24).

Barry does not disclose expressly a document in an original format;
wherein the second document was created in said original format by a first document authoring application;
in response to the request, causing the second document to be converted from the original format to the merge format to create a second merge document;
wherein the original format is a format that is not supported by the output device and therefore needs to be converted to another format that is supported by the output device in order to be properly interpreted by the output device.

Schwier discloses a document in an original format (Figure 6; Winword document 35);
wherein the second document was created in said original format by a first document authoring application (Winword);
in response to the request (In order to merge the system must receive a merge command/request from the browser or program code), causing the second document to be converted from the original format to the merge format to create a second merge document (Document

converted to PCL format; Column 8, lines 13-14); wherein the original format is a format that is not supported by the output device and therefore needs to be converted to another format that is supported by the output device in order to be properly interpreted by the output device(Figure 8 shows an Application 45 created in Microsoft Word which is converted by Printer Processor 49 to PCL which is a printer language that the printer understands).

Schwier & Barry are combinable because they are from the same field of endeavor of image processing; e.g. both references discloses methods of merging print jobs and converting them into a format that can be understood by printers. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to convert a document from e.g. Word for Windows format to PCL or Postscript prior to merging that document with another PCL or Postscript formatted document. The suggestion/motivation for doing so is to avoid substantial time delays because the static data must be continuously transmitted from the generating computer system to the printer device, i.e. with every individual document as disclosed by Schwier in the Background of Invention. Schwier further discloses that when two documents are merged and when the data from one document contains the same information, that RAM memory, disk storage, transmission capacity etc. are adversely affected and result in reduced printing performance. As a result, data to be displayed or printed must be first rasterized by a raster image processor (RIP), which utilizes complex and time-consuming computational routines which further increase production time to an economically impractical level. Therefore, it would have been obvious to combine Schwier's conversion of a Windows based document into a print language such as PCL

or postscript with Barry's Distributed Print Job Method to obtain the invention as specified to quickly produce customized and/or personalized information within a single production run.

Regarding Claim 2: (original)

Schwier further discloses the method of claim 1 further comprising:
generating the first merge document in said merge format by converting a first original document from an original format to the merge format (Document converted to PCL format; Column 8, lines 13-14).

Regarding Claim 3: (original)

Schwier further discloses the method of claim 1, wherein the merge format is Standard Printing and Imaging Format (SPIF) (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript').

Regarding Claim 4: (original)

Schwier further discloses the method of claim 3, wherein the merge format is PDL Postscript (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript').

Regarding Claim 5: (original)

Schwier further discloses the method of claim 1, wherein the first document is a background template document and the second document is an overlay document (Column 8, lines 64-67; 'The placement type as an **overlay** (complete superimposition) or a **watermark** (macro information only in the background) within the document **can be selected** with the selection field 44').

Regarding Claim 6: (previously presented)

Schwier further discloses the method of claim 5, wherein the background template document is originally created by a second document authoring **application** (Column 5, lines 23-30; 'Various application programs in turn run under this operating system, for example the **application** 10 Winword 97.RTM. from the Microsoft Office 97.RTM. package'); and

wherein the second document authoring application is different (Column 5, lines 35-38; 'The variable data areas are intended to be filled with variable data that are stored in a separate datafile (a Word document, data bank, an Excel document, etc.) from said first document authoring application.

Regarding Claim 7: (original)

Schwier further discloses the method of claim 5, wherein the background template document is created in a second original format (Column 5, lines 35-38; 'The variable data areas are intended to be filled with variable data that are stored in a separate datafile (a Word document, data bank, an Excel document, etc.) and converted from the second original format to the merge format (Document converted to PCL format; Column 8, lines 13-14).

Regarding Claim 8: (Currently Amended)

Barry and Schwier further discloses the method of claim 1, wherein causing the second document to be converted from the original format to the merge format comprises the merge utility converting the second document to the merge format.

Note: The Examiner respectfully believes that the combination of references discloses this feature and that this limitation is addressed in the rejection of claim one, note the Applicant's limitation at lines 7-9.

Regarding Claim 9: (Currently Amended)

Schwieger further discloses the method of claim 1, wherein the converting of the second document from the original format to the merge format to create the second merge document includes:

generating, based on the original format, a set of conversion instructions (e.g., The instructions that are input at a user interface which for example may describe how a template or overlay is to appear; Column 4, lines 24-27; The conversion that is controlled by the parameters that were previously input via the Input module 59; Column 9, lines 65-67);

passing the set of conversion instructions to a document authoring application (The 'logical linking' of reference data and parameters described at Column 4, lines 15-30); and

the first document authoring application generating the second merge document based on said set of conversion instructions (Column 4, lines 15-20).

Regarding Claim 10: (previously presented)

Schwieger further discloses the method of claim 1, wherein the method further comprises receiving a request to merge documents containing information about a

document authoring application (Column 4, lines 25-26; 'the referencing is thereby particularly controlled via data that are input via a user interface') that created the second document; and

wherein the converting of the second document from the original format to the merge format to create the second merge document includes:

generating, based on the information about the document authoring application, a set of conversion instructions (The program code or device which enables the PCL converter 18 in Figure 2) to convert the second document into said second merge document;

passing the set of conversion instructions to the document authoring application (Column 9, lines 59-62; "Enhanced Print Environment (EPE) Print Processor" 49a does not forward the EMF data directly to the port monitor 51 but calls the converter unit 58, wherein the EMF data stream is converted into a PCL print data stream 60'); and

the document authoring application generating the second merge document based on said set of conversion instructions (Column 9, lines 65-67, 'The conversion is thereby controlled by the parameters that were previously input via the input module 59').

Regarding Claim 11: (original)

Schwier further discloses the method of claim 1, wherein the composite merge document is in the merge format (Column 3, lines 56-67).

Regarding Claim 12: (original)

Schwier further discloses the method of claim 1, wherein the composite merge document is a **template** for creating other documents (FIG. 5 shows a **master** document 25).

Regarding Claim 13: (previously presented)

Schwier further discloses the method of claim 1, further comprising;

Receiving at the merge utility, a request to merge wherein the steps of converting the second document and merging the first merge document and the second merge document are both performed in response to the merge utility receiving the request to merge documents. documents (The program code which is embodied on a computer readable media and operable to requests the merge utility described in Column 6, lines 8-18 to merge documents and in Claim 20.)

Regarding Claim 14: (previously presented)

Schwier further discloses the method of claim 1 further comprising:

receiving at the merge utility, a request to merge documents (Column 7, lines 20-25; in order to merge the system must receive a merge command);

generating the first merge document in said merge format by converting a first original document from an original format to the merge format (See PCL converter 18 in Figure 2);

wherein the merge format is Standard Printing and Imaging Format (SPIF) (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript'); wherein the first document is a background template document and the second document is an overlay document (Column 8, lines 64-67; 'The placement type as an **overlay** (complete superimposition) or a **watermark** (macro information only in the background) within the document **can be selected** with the selection field 44').

wherein the background template document is originally created by a first document authoring application (e.g., WinWord Application 10 in Figure 2); and

wherein the second document authoring application that is different from said first document authoring application (e.g., Excel document);

wherein the background template document is created in a second original format and converted from the second original format to the merge format (e.g., Master Document described in Column 9, lines 32-35).

Regarding Claim 29: (previously presented)

Schwier discloses the method of Claim 1, wherein the first merge document is a version of a first document that has been converted from an original format to the merge format (e.g., Word application converted to PCL as shown in Figure 9).

Regarding Claim 30: (previously presented)

Schwier further discloses the method of Claim 1, wherein the merge utility performs the step of converting a second document from an original format to the merge format to create a second merge document by causing the first document authoring application to convert the second document to to said second merge document (Figure 8 shows an Application 45 created in Microsoft Word which is converted by Printer Processor 49 to PCL which is a printer language that the printer understands).

Regarding Claims 15-28, and 31:

The proposed combination of Barry and Schwier, explained in the rejection of method claims 1-14 and 29, renders obvious the steps of the machine readable storage medium of Claims 15-28 and 31 because these steps occur in the operation of the proposed combination as discussed above. Thus, the arguments similar to that presented above for claims 1-14 and 29 are equally applicable to Claims 15-28 and 31.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sciatto (US 6,330,073) discloses A system and method for generating a plurality of customized documents having at least one portion of common information and at least one portion of variable information.

Examiner Notes

6. The Examiner cites particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully considers the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or as disclosed by the Examiner.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. McLean whose telephone number is (571)270-1679. The examiner can normally be reached on Monday through Friday 7:30AM-4:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571.272.7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Neil R. McLean/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625